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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stephen C P Joseph

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

03/26/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/533,743	Applicant(s) JOSEPH, STEPHEN C P	
	Examiner MADELINE GONZALEZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to applicant's amendment dated January 22, 2009

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 10, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303).

With respect to **claim 10**, Kaltenbach discloses a spray gun siphon cup, as shown in Fig. 1, having:

- a container 30, as shown in Fig. 2, having a collapsible side wall 20 and a base on which it can stand unsupported in an upright position and having a filler opening and a filter 32;
- the filter 32 including an elongate tubular body closed at one end and open at the other end, and fits in the filler opening so that the filter body extends away from the opening within the container 30; and
- wherein the tubular body of the filter 32 has a surface area and volume within the container 30; and
- the filter 32 is sufficiently rigid to maintain an elongate, tubular shape.

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Kaltenbach **lacks** the filter 32 having a support collar and being sufficiently flexible to allow it to collapse as the container side wall collapses.

Williams discloses a filter bag unit 24, as shown in Fig. 2, said unit 24 being collapsible in order to easily remove and install the unit, as shown in Fig. 4. The unit 24 has a support collar 42. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the filter disclosed by Kaltenbach with a collapsible filter as taught by Williams in order to easily remove and install a filter bag (see col. 6, lines 45-47).

With respect to **claim 6**, Williams discloses wherein the support collar 42 of the filter 24 is connected to a cage 40 that surrounds the tubular body of the filter 24 within the container 10 which cage 40 is sufficiently flexible to allow the filter 24 to collapse if the container containing it collapses, as shown in Fig. 4.

With respect to **claim 7**, Williams discloses wherein the cage 40 includes a plurality of legs 48 extending from the support collar 42 at the open end of the tubular body to a base member at the closed end of the tubular body, as shown in Fig. 2.

With respect to **claim 9**, Williams discloses wherein the tubular body of the filter 24 is provided with at least one annular support hoop 50, 54, spaced from the collar 42, as shown in Fig. 2.

With respect to **claim 14**, Kaltenbach discloses wherein the elongate tubular body of the filter 32 is tapered toward the closed end, as shown in Fig. 3.

With respect to **claim 17**, Kaltenbach discloses wherein the opening is not an open end of the container, since the opening is on the cover 28, as shown in Fig. 3. The term “filler opening” has been considered an intended use recitation.

With respect to **claim 18**, Kaltenbach discloses a container 19 and a circular lid 28, and the opening is separate from an opening (such as the open end of the container 30) to be connected to a spraying apparatus and is in the lid 28 and has a diameter of one-half the diameter of the lid or less, as shown in Fig. 3.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303) as applied to claim 10 above, and further in view of Brown (U.S. 2,175,714).

Claim 15 adds the further limitation of wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the container.

Claim 16 adds the further limitation of wherein the container is characterized by a shape having a longitudinal axis and the filler opening is offset from the container longitudinal axis.

Kaltenbach as modified by Williams **lacks** the limitations of claims 15 and 16.

Brown discloses a filtering receptacle, as shown in Fig. 1, having a filter 13 oriented at an angle not parallel to a side wall of a receptacle 1, and an opening 4 offset from the receptacle 1 longitudinal axis. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to relocate the filter and opening disclosed by Kaltenbach to an angle not parallel to the side wall of the container, and offset from the longitudinal axis of the reservoir, respectively, as taught by Brown since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Joseph et al. (WO 02/085533 A1) [hereinafter Joseph WO02] and Joseph et al. (WO 98/32539) [hereinafter WO98].

With respect to **claims 10 and 11**, Joseph WO02 discloses a paint reservoir attached to a spray gun, as shown in Fig. 24, having:

- a container 309 having a collapsible sidewall (see page 24, lines 15-21) and a base on which it can stand unsupported in an upright position, as shown in Fig. 21;
- a filler opening 330;
- a collapsible filter that fits in the filler opening 330 (see page 27, lines 16-22);

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- the container including an open-topped container 309 and a lid 310 arranged to close the open end of the container 309 and forming the end wall in which the filler opening 330 is formed;
- the container 309 being collapsible as liquid is withdrawn from the container 309 (see page 24, lines 15-21).

Joseph WO02 **lacks** the filter having a tubular body and a support collar integral with the tubular body.

Joseph WO98 teaches a spray gun and reservoir assembly, as shown in Fig. 12, having a filter 37 having a body closed at one end and open at the other end, the open end being provided with a collar 38 integral with the body and fits in a filler opening. The filter 37 filters the paint before exiting the spray gun. The body of the filter can have any shape (see page 14, lines 17-18). It would have been obvious to provide the assembly disclosed by Joseph WO02 with a filter having a collar as taught by Joseph WO98 in order to filter the paint before using the spray gun and to properly support the filter at the filler opening (see page 14, lines 4-16). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tubular shape to the filter disclosed by Joseph WO02 since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)), and since Joseph WO98 is suggesting that any shape can be used (see page 14, lines 17-18).

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With respect to **claim 9**, Williams discloses wherein the tubular body of the filter 24 is provided with at least one annular support hoop 50, 54, spaced from the collar 42, as shown in Fig. 2.

With respect to **claim 12**, Joseph WO02 discloses wherein the container 309 has a flexible sidewall and a comparatively rigid base, as shown in Fig. 21, and the sidewall is foldable to move the base towards the lid 310 as liquid is withdrawn from the container 309 (see page 24, lines 15-21). The limitation “the reservoir” in line 4 of claim 12 lacks antecedent basis.

With respect to **claim 13**, Joseph WO02 discloses wherein the lid 210, 310, is provided with an extension sleeve or cage 280, 281 surrounding the container 209, 309, as shown in Fig. 19.

With respect to **claim 14**, Joseph WO98 discloses wherein the elongate tubular body of the filter 37 is tapered toward the closed end, as shown in Fig. 12.

With respect to **claim 15**, Joseph WO02 discloses wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the container 309, as shown in Fig. 24

With respect to **claim 16**, Joseph WO02 discloses wherein the container 309 is characterized by a shape having a longitudinal axis and the filler opening 330 is offset from the container longitudinal axis, as shown in Fig. 24.

With respect to **claim 17**, Joseph WO02 discloses wherein the filler opening 330 is not an open end of the container 309, as shown in Fig. 24.

With respect to **claim 18**, Joseph WO02 discloses wherein the container 309 includes a container 309 and a circular lid 310, and the filler opening 330 is separate from an opening to be connected to a spraying apparatus 301 and said filler opening 330 is in the lid 310 and has a diameter of one-half the diameter of the lid 310 or less, as shown in Fig. 24.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joseph WO02 (WO 02/085533 A1) and Joseph Wo98 (WO 98/32539) as applied to claim 10 above, and further in view of Williams (U.S. 5,061,303).

With respect to **claim 6**, the combination of Joseph WO02 and Joseph WO98 lacks a cage sufficiently flexible to allow the filter to collapse if the container containing it collapses.

Williams discloses wherein the support collar 42 of the filter 24 is connected to a cage 40 that surrounds the tubular body of the filter 24 within the container 10 which cage 40 is sufficiently flexible to allow the filter 24 to collapse if the container containing it collapses, as shown in Fig. 4.

Williams discloses a filter bag unit 24, as shown in Fig. 2, said unit 24 having a collar 42 connected to a cage 40 that surrounds a tubular body 38, said cage 40 being collapsible in order to easily remove and install the unit, as shown in Fig. 4. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the filter disclosed by the combination of Joseph WO02 and Joseph WO98 with a collapsible cage as taught by Williams in order to easily remove and install a filter (see col. 6, lines 45-47).

With respect to **claim 7**, Williams discloses wherein the cage 40 includes a plurality of legs 48 extending from the support collar 42 at the open end of the tubular body to a base member at the closed end of the tubular body, as shown in Fig. 2.

Response to Arguments

Applicant's arguments filed on January 22, 2009 have been fully considered but they are not persuasive.

In response to applicant's argument that Kaltenbach lacks a container with a collapsible sidewall and a base that can stand unsupported in an upright position:

Kaltenbach meets this limitation since it discloses a container 30, having a collapsible sidewall 20 and a base on which said container 30 can stand unsupported, as shown in Fig. 3.

In response to applicant's arguments regarding the Williams reference: Williams teaches a collapsible filter in order to easily remove and install a filter bag and it would have been obvious to combine the references for this reason. All that claim 10 requires is a collapsible filter, and Williams is providing that teaching. Claim 6 requires a flexible cage, and Williams teaches such a cage.

In response to applicant's argument that Williams lacks a cage surrounding the filter: The definition of the word "surrounds" includes "to form an enclosure around" and "something serving as a border" (see Webster's New World Dictionary 3rd ed.) and Williams teaches a cage 40 surrounding, or forming an enclosure around the bag, or serving as a border, as shown in Fig. 2.

In response to applicant's argument regarding claim 18: Kaltenbach meets the limitations of claim 18, as stated in the Office Action. Kaltenbach discloses a container 19 and a circular lid 28, and the opening is separate from an opening (such as the open end of the container 30) to be connected to a spraying apparatus and said opening is in the lid 28 and has a diameter of one-half the diameter of the lid or less, as shown in Fig. 3.

In response to applicant's argument regarding the opening in which the filter screen is located in Kaltenbach being characterized as the filler opening: a recitation of the intended use of the claimed invention must result in a structural difference between

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the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the opening having the screen disclosed by Kaltenbach is capable of receiving a liquid.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez
Patent Examiner
March 20, 2009

/Krishnan S Menon/
Primary Examiner, Art Unit 1797